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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/941,605	09/30/97	WOOD	E ITI-138C

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IM71/1210

EXAMINER

HAYES, J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED:

12/10/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/941,605

Applicant(s)

Wood

Examiner
Jennifer Hayes

Group Art Unit
1772



☒ Responsive to communication(s) filed on Aug 25, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 9-11 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 9-11 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 07/934,678

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

1. The terminal disclaimer filed on 8/25/98 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 5,692,543 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

2. The rejections made under this section in the previous Office Action are withdrawn in view of the Applicant's assertion of his claim for priority. The following are new art rejections.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 9 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Long, Jr. et al. (US 5,108,533). Long Jr. et al. teach a flexible tubular member impregnated with a thermoplastic resin and a flexible retainer secured thereto which is ultimately positioned within the main pipe proximate the service pipe terminal end. (Abstract). The flexible tubular member is preferably constructed of a felt fabric which is a fibrous material. While the tube of Long, Jr. et al. meets the limitations of the presently claimed invention, the phrases, "capable of being impregnated" and "adapted to engage and conform" do not serve as positive limitations which serve to patentably distinguish the present invention from the prior art since only the ability to perform the stated functions.

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Claim Rejections - 35 USC § 103

5. The rejections made under this section in the previous Office Action are withdrawn in view of the Applicant's assertion of his claim for priority. The following are new rejections.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Long, Jr. et al. as applied above. Long, Jr. et al. do not specifically teach the liner including further reinforcement at the junction between the tubular fibrous material and the collar or a beaded end for reinforcement. However tubular reinforcement materials are well known to those of ordinary skill in the art. Additionally, Long, Jr. et al. do teach that the flexible tube may have a reinforced portion to be secured to metal grommets by flame bonding, sewing, or adhesive so that the grommets cannot readily pull or tear through the felt fabric of the tube. (Col. 6, lines 13-26).

Similarly the felt fabric of the tube is preferably secured to the flexible retainer by sewing, adhesive or flame bonding. (Col. 6, lines 48-56). It would have been obvious to one of ordinary skill in the art to use a reinforced portion of the tube at the junction between the retainer and the tube in a similar fashion as the portion to be secured to metal grommets to prevent tearing of the felt fabric which would render the tube useless. A beaded end for reinforcement would have been an obvious matter of design choice well within the purview of the skilled artisan.

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Double Patenting

8. The double patenting rejections made in the previous Office Action are withdrawn in view of the Terminal Disclaimer filed 8/25/98 which has been deemed proper and is recorded.

Response to Arguments

9. Applicant's arguments with respect to claims 9-10 and newly added claim 11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer M. Hayes whose telephone number is (703) 308-9545. The examiner can normally be reached on Monday through Friday from 7:00 a.m. to 4:30 p.m. If the attempts to reach the Examiner are unsuccessful, the examiner's supervisor, Ellis P. Robinson, can be reached by dialing (703) 308-2364.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose phone number is (703) 308-0661. The fax phone number for this group is (703) 305-5408.

Jmh
jmh

December 7, 1998

Ellis P. Robinson
Ellis Robinson
Supervisory Patent Examiner
Technology Center 1700